

## REMARKS

By this Amendment, Applicant proposes to amend claims 52-54 to address minor informalities. Claims 1-54 remain pending.

In the final Office Action of November 25, 2003<sup>1</sup> ("Office Action"):

1. Claims 1-4, 7-10, 21-24, 27-30, 41-43 and 46-48 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,434,467 to *Scott* ("*Scott*");
2. Claims 1-6, 8, 10-26, 28 and 30-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,612,733 to *Flohr* ("*Flohr*");
3. Claims 9 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Flohr* in view of U.S. Patent No. 5,983,201 to *Fay* ("*Fay*"),
4. Claims 7 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Flohr* and *Fay* further in view of U.S. Patent No. 6,502,583 to *Utsugi* ("*Utsugi*") and U.S. Patent No. 6,108,437 to *Lin* ("*Lin*"); and
5. Claims 51-54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,034,698 to *Yasuda* ("*Yasuda*") in view of *Skincheck*<sup>TM</sup> (Omniconcontrols, September 2000) ("*Skincheck*").

Applicant submits that the rejections set forth in the final Office Action should be withdrawn for the reasons discussed below.

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<sup>1</sup> The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

### **Regarding the Interview Summary**

The Interview Summary asserts that “the claims...read on diagnostic systems using optical imaging.” Applicant respectfully disagrees with this conclusory statement and calls attention to the fact that the Examiner has not provided any evidence, beyond conjecture, to support the assertion.

### **Rejection of claims 1-4, 7-10, 21-24, 27-30, 41-43 and 46-48 based on *Scott***

Applicant respectfully traverses the rejection of claims 1-4, 7-10, 21-24, 27-30, 41-43 and 46-48 under 35 U.S.C. § 102(b) based on *Scott* because *Scott* fails to anticipate the claims. In order to properly anticipate Applicant’s claimed invention under 35 U.S.C. § 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the...claim[s].” See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P. § 2131 (8th Ed. 2001), p. 2100-69. *Scott* does not teach each and every element recited in Applicant’s claims, as required.

Claim 1, for example, recites a method including:

sending a signal to the display device to generate light in a  
predetermined wave length range for irradiating the body part ...  
and

processing the image to derive information about at least one  
characteristic of the body part.

*Scott* does not teach at least the above subject matter. As shown in Fig. 5 of *Scott*, “lights for illuminating the user’s face” are positioned to the sides of a screen (See col. 6, lines 59-64). *Scott*, however, does not teach “sending a signal to the display device to generate light in a

predetermined wave length range for irradiating the body part,” as claimed. The mere disclosure of illuminating a user’s face with lights that are positioned to the sides of a screen does not teach “sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part,” as recited in claim 1. The Office Action asserts (at page 7) that “the illumination means of *Scott* is part of the display device of *Scott* which comprises a display screen or monitor, illumination device and projection means.” Even if this statement were valid, *Scott* still does not teach “sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part.” *Scott* merely mentions lights for illuminating a face.

Further, *Scott* does not teach the “processing” feature recited in claim 1. As discussed in the interview, *Scott* fails to disclose “processing [an] ... image to derive information about at least one characteristic of the body part,” as claimed. *Scott* merely mentions superimposing an image of “fashion items over and around ... [a reflected] image of the viewer” (col. 3, lines 60-61; col. 4, lines 24-28). Without explicitly conceding that *Scott* fails to teach the “processing” recitation, the Examiner acknowledged, during the interview, an uncertainty as to whether *Flohr* discloses this feature. For at least the reasons advanced above, *Scott* does not teach the claimed “sending” and “processing” and, thus, does not teach each and every feature recited in claim 1.

As set forth above, anticipation under 35 U.S.C. § 102(b) requires that each and every claim element be disclosed in as complete detail as is in the claim by the applied reference. *Scott* does not teach each and every feature of independent claim 1 and thus, as a matter of law, cannot anticipate claim 1. The rejection of independent claim 1 under 35 U.S.C. §102(b) as anticipated by *Scott* should therefore be withdrawn.

Independent claim 21, although of different scope, includes recitations paralleling those in claim 1 discussed above. In particular, claim 21 recites, *inter alia*:

means for sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part ...  
and

means for processing the image to derive information about at least one characteristic of the body part.

For reasons similar to those presented above in connection with claim 1, *Scott* fails to anticipate claim 21.

Independent claims 41 and 46, although of different scope, also include recitations having some relation to certain subject matter in claim 1 discussed above. Claim 41 recites, *inter alia*:

sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part; and

capturing an image of the body part with the image capture device....

And claim 46 recites, in part:

means for sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part;  
and

means for capturing an image of the body part with the image capture device....

As explained above in connection with claim 1, *Scott* fails to teach or suggest “sending a signal to the display device,” as claimed. *Scott* also fails to teach, for example, “capturing an image,” as claimed. As discussed in the interview, *Scott* does not teach “capturing an image of the body part with [an] ... image capture device.” Instead, *Scott* describes a “surface ... on which a projected image ... is superimposed over a reflected facial image” (col. 4, lines 21-26, emphasis added). A surface that reflects an image does not constitute an image capture device

that captures an image. Because *Scott* fails to teach at least the “sending” and “capturing” features of claims 41 and 46, *Scott* fails to anticipate these claims.

As *Scott* fails to anticipate claims 21, 41, and 46, the rejection of claims 21, 41 and 46 under 35 U.S.C. § 102(b) based on *Scott* should be withdrawn. The rejection of claims 2-4, 7-10, 22-24, 27-30, 42, 43, 47 and 48 should be withdrawn as well, at least by virtue of the respective dependence of those claims from base claims 1, 21, 41 and 46. Accordingly, Applicant requests withdrawal of the rejection of claims 1-4, 7-10, 21-24, 27-30, 41-43 and 46-48 under 35 U.S.C. §102(b) based on *Scott* and the timely allowance of these pending claims.

**Rejection of claims 1-6, 8, 10-26, 28 and 30-50 based on *Flohr***

Applicant respectfully traverses the rejection of claims 1-6, 8, 10-26, 28 and 30-50 under 35 U.S.C. § 102(b) because *Flohr* fails to anticipate the claims.

With regard to claim 1, *Flohr* does not teach “sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part,” as claimed. Instead, *Flohr* merely mentions that a camera may operate with a light source to reduce glare during image capture (col. 2, lines 58-67). Without explicitly conceding that *Flohr* fails to teach the “sending” recitation, the Examiner indicated during the interview that *Flohr* “does not appear” to disclose this feature. The Office Action alleges (at page 7) that “signals are sent to the display device of *Flohr* to activate it.” Even if this were true, *Flohr* does not teach sending signals “to generate light in a predetermined wave length range,” as claimed. Sending signals to activate a display device does not constitute sending a signal “to generate light in a predetermined wave length range,” as claimed.

Further, as discussed in the interview, *Flohr* does not teach “processing the image to derive information about at least one characteristic of the body part,” as recited in claim 1. Applicant points out that the Examiner indicated an “uncertainty” regarding *Flohr* as applied to

this claimed subject matter. Because *Flohr* does not teach at least the “sending” and “processing” recited in claim 1, *Flohr* does not anticipate claim 1. The rejection of claim 1 under 35 U.S.C. § 102(b) based on *Flohr* should therefore be withdrawn.

Independent claims 21, 41, and 46, although of different scope, recite subject matter similar to the “sending” recited in claim 1. Further, similar to claim 1, claim 21 recites “processing the image to derive information about at least one characteristic of the body part.” *Flohr* fails to teach at least the “sending” feature recited in claims 21, 41, and 46 and the “processing” feature recited in claim 21. *Flohr* therefore fails to anticipate these claims. Claims 2-6, 8, 10-20, 22-26, 28, 30-40, 42-45, and 47-50 depend from claims 1, 21, 41, and 46, respectively, and are not anticipated by *Flohr* for at least the same reasons as set forth above in connection with claims 1, 21, 41, and 46. Accordingly, Applicant requests withdrawal of the rejection of claims 1-6, 8, 10-26, 28, and 30-50 under 35 U.S.C. § 102(b) based on *Flohr* and the timely allowance of these pending claims.

**Rejection of claims 9 and 29 under 35 U.S.C. § 103(a)**

Applicant respectfully traverses the rejection of claims 9 and 29 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established based on *Flohr* and *Fay*. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Initially, Applicant submits that *Flohr* is nonanalogous art and therefore an improper reference against claims 9 and 29 under 35 U.S.C. § 103(a). *Flohr* is not in the same field of endeavor as claims 9 and 29. *Flohr* is directed to videoconferencing and is dissimilar to claims 9 and 29, which are directed to beauty analysis. Further, *Flohr* is not reasonably pertinent to the particular problem addressed by claims 9 and 29. That is to say, *Flohr*, which is directed to facilitating “face-to-face communication between parties to a videoconference,” would not logically have commended itself to an inventor’s attention in considering the problems associated with beauty analysis and/or enhancing the quality of beauty assistance. Accordingly, *Flohr* is nonanalogous art and should not be used as a reference against claims 9 and 29 under 35 U.S.C. § 103(a). See M.P.E.P. § 2141.01(a). For at least this reason, a *prima facie* case of obviousness cannot be established using *Flohr* and the rejection of claims 9 and 29 should be withdrawn.

*Flohr*’s status as nonanalogous art notwithstanding, a *prima facie* case of obviousness has not been established because, among other things, *Flohr* and *Fay*, alone and in combination, fail to teach or suggest each and every element recited in Applicant’s claims.

Claims 9 and 29 depend from claims 1 and 21, respectively, and therefore include all of the subject matter recited in claims 1 and 21, respectively. In particular, claims 9 and 29 recite, by virtue of such dependency:

...sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part [and]

...processing the image to derive information about at least one characteristic of the body part.

As explained above, *Flohr* fails to teach at least the above features. *Flohr* also fails to suggest these recitations.

*Fay* fails to cure all of *Flohr*'s deficiencies. *Fay* discloses a system for purchasing fitted eyeglasses (Abstract). The system includes a "remote electronic store," which downloads images to a customer's computer showing "how the customer would appear wearing different eyeglasses" (Abstract). *Fay* fails to teach or suggest "sending a signal to ... [a] display device to generate light in a predetermined wave length range for irradiating the body part," as claimed. *Fay* further fails to teach or suggest "processing the image to derive information about at least one characteristic of the body part," as claimed.

Accordingly, neither *Flohr* nor *Fay*, nor any combination thereof, teaches or suggests each and every feature recited in claims 9 and 29<sup>2</sup>. For at least this reason, a *prima facie* case of obviousness has not been established with respect to these claims.

Even if all of the elements recited in claims 9 and 29 could be found in *Fay* and *Flohr* and *Flohr* were a proper reference—to which Applicant does not acquiesce—a *prima facie* case of obviousness has not been and cannot be established at least because there is no motivation to combine the references. Determinations of *prima facie* obviousness must be supported by a finding of "substantial evidence." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless "substantial evidence" found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

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<sup>2</sup> The Office Action concedes (at page 3) that *Flohr* fails to disclose "prescribing at least one beauty product," as claimed, and relies on *Fay* in an attempt to cure the *Flohr*'s deficiencies. Although Applicant notes other features of claims 9 and 29 that distinguish the claims from the references, Applicant does not acquiesce to the allegations in the Office Action regarding the combination of *Flohr* and *Fay* as applied to the recitation of "prescribing at least one beauty product."



In this case, there is no “substantial evidence” in the record to support the alleged combination of *Flohr* and *Fay*, and the requisite “clear and particular” motivation to support a *prima facie* case of obviousness is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan having the applied art before him would have been motivated to combine the references in a manner resulting in Applicant’s claimed invention. According to the Office Action:

[i]t would have been obvious ... that the method of capturing and processing an image of a body part as taught by *Flohr* can be used to provide accurate, color-corrected images suitable for customizing the selection of beauty product[s] as disclosed by *Fay*.

This conclusory statement is not supported by substantial evidence on the record and does not evidence that a skilled artisan would have been motivated to combine *Flohr* and *Fay* in a manner resulting in Applicant’s claimed combination. Regardless of whether or not *Flohr* could provide “accurate, color-corrected images,” the Office Action provides no evidence or reasoning to show why a skilled artisan would have been motivated to combine *Flohr* and *Fay* in a manner resulting in the invention defined by claims 9 and 29. The Office Action merely provides a description of how *Fay* allegedly teaches certain features but fails to provide more than conclusory statements supporting a motive for choosing a particular combination. Indeed, nothing would be gained by combining *Fay*’s system for purchasing eyeglasses with *Flohr*’s videoconferencing system, and a skilled artisan would not have been motivated to combine the references.

Applicant calls attention to M.P.E.P. § 2143.01, which makes clear that

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (citations omitted).

The Office Action does not show that the cited art “suggests the desirability of the” combination. The Office Action also does not show why, other than to attempt to meet the terms

of Applicant's claims, a skilled artisan would have been motivated to combine the references. No objective reason for combining the applied art to achieve the invention defined by claims 9 and 29 has been established.

Applicant notes that the requirements for establishing *prima facie* obviousness must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). As M.P.E.P. § 2142 articulates:

Knowledge of applicant's disclosure must be put aside....  
[I]mpermissible hindsight must be avoided and the legal  
conclusion must be reached on the basis of the facts gleaned from  
the prior art.

Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references. Furthermore, Applicant's claims were used to reconstruct the prior art. A skilled artisan would not have been motivated, without consulting Applicant's disclosure, to combine *Flohr* and *Fay* in a manner resulting in the invention defined by Applicant's claims. For at least the reasons advanced above, the requisite motivation to combine is lacking.

Because the applied art does not teach or suggest each and every claim recitation and the required motivation to combine is lacking, a *prima facie* case of obviousness has not been established with respect to claims 9 and 29. The rejection of claims 9 and 29 under 35 U.S.C. § 103(a) should therefore be withdrawn. Applicant, thus, requests withdrawal of the rejection of claims 9 and 29 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

**Rejection of claims 7 and 27 under 35 U.S.C. § 103(a)**

The rejection of claims 7 and 27 should be withdrawn for at least the following reasons.

First, *Flohr* is nonanalogous art for claims 7 and 27 and therefore should not be used as a reference against claims 7 and 27 under 35 U.S.C. § 103(a). Further, notwithstanding *Flohr*'s

status as nonanalogous art, *Flohr*, *Fay*, *Utsugi*, and *Lin*, alone and in combination, fail to teach or suggest each and every feature recited in claims 7 and 27, as discussed below. Moreover, even if the features of claims 7 and 27 could be found in some combination of *Flohr*, *Fay*, *Utsugi*, and *Lin*, the requisite motivation to combine the references is lacking, as also discussed below.

Claims 7 and 27 depend from claims 1 and 21, respectively, and therefore include all of the features recited in claims 1 and 21. As explained above, *Flohr* does not teach or suggest each and every feature recited in claims 1 and 21 and required by claims 7 and 27. Further, as explained above, *Fay* fails to cure *Flohr*'s deficiencies. *Utsugi* and *Lin*, moreover, do not cure the deficiencies of *Flohr* and *Fay*.

*Utsugi* does not disclose, for example, the "sending" recited in claims 7 and 27. With *Utsugi*'s system, a user can select a stored image of a face (e.g., of a model or actress) as a desired face (col. 8, lines 8-22). An image of the user's face is then captured and "mixed" with the image of the desired face "to make the former image closer to the latter" (col. 8, lines 23-30). After an ideal face is determined, makeup procedures are provided to the user (col. 8, lines 51-64). *Utsugi*, however, fails to teach or suggest at least "sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part," as recited in claims 1 and 21, from which claims 7 and 27 depend, respectively.

*Lin* describes a system for determining "if a face is present in ... [an] image," determining "a position of the face in the image," and "extracting ... features from the face." (Abstract.) *Lin*, however, fails to teach or suggest at least "sending a signal to the display device to generate light in a predetermined wave length range for irradiating the body part," as recited in claims 1 and 21. Accordingly, neither *Flohr*, *Fay*, *Utsugi*, nor *Lin*, nor any combination thereof,

teaches or suggests each and every feature recited in claims 1 and 21, from which claims 7 and 27 depend.<sup>3</sup>

Moreover, there is no motivation to combine the applied references. There is no “substantial evidence” in the record to support the alleged combination of *Flohr*, *Fay*, *Utsugi*, and *Lin*, and the requisite “clear and particular” motivation to support a *prima facie* case of obviousness is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan having the applied art before him would have been motivated to combine the references in a manner resulting in Applicant’s claimed invention. According to the Office Action, a skilled artisan would have combined the applied references “to customize and enhance the selection of beauty product[s] as taught by *Flohr* and *Fay*.” This conclusory statement is not supported by substantial evidence on the record and does not evidence that a skilled artisan would have been motivated to combine *Flohr*, *Fay*, *Utsugi*, and *Lin* in a manner resulting in Applicant’s claimed combination. The Office Action provides no explanation or reasoning to show that combining the applied art would in fact “enhance” or “customize” beauty product selection as allegedly taught by *Flohr* and *Fay*. And the Office Action points to no mention from the applied art of such “enhancing” and “customizing.” Regardless of whether or not the alleged combination could “customize and enhance the selection of beauty product[s],” the Office Action provides no evidence or reasoning to show why a skilled artisan would have been motivated to combine *Flohr*, *Fay*, *Utsugi*, and *Lin* in a manner resulting in the invention defined by claims 7 and 27. The Office Action merely provides a description of how the references allegedly teach certain

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<sup>3</sup> The Office Action concedes (at page 5) that *Flohr*, *Fay*, and *Utsugi* fail to disclose “processing the image ... using artificial intelligence,” as claimed. Although Applicant notes aspects of claims 1 and 21 that distinguish the claims from the references, Applicant does not acquiesce to the allegations in the Office Action regarding the combination of *Flohr*, *Fay*, *Utsugi*, and *Lin* as applied to the recitation of “processing the image ... using artificial intelligence.”

features but fails to provide more than conclusory statements supporting a motive for choosing Applicant's claimed combination. Indeed, Applicant submits that a skilled artisan would not have been motivated to combine the references. For these reasons, and for the reasons presented above in connection with claims 9 and 29, the requisite motivation to combine is lacking.

Because the applied art does not teach or suggest each and every claimed feature and the required motivation to combine is lacking, a *prima facie* case of obviousness has not been established with respect to claims 7 and 27. The rejection of claims 7 and 27 under 35 U.S.C. § 103(a) should therefore be withdrawn. Accordingly, Applicant requests withdrawal of the rejection of claims 7 and 27 under 35 U.S.C. § 103(a) and the timely allowance of these pending claims.

*Regarding the allegation that the features of claims 7 and 27 were "well known"*

The Office Action alleges that *Lin* teaches a "system and method well known in the art of manipulating facial images using artificial intelligence" (pg. 5). To the extent the Office Action is relying on Official Notice in alleging that certain subject matter was well known, Applicant calls attention to the provisions of M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. Further, any facts asserted as well-known should serve only to "fill in the gaps" in an insubstantial manner. It is never appropriate to rely solely on "common knowledge" without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicant submits that the features recited in claims 7 and 27 are not unquestionably well-

known, and the Office Action has failed to demonstrate the contrary. Simply stating that a system and method was well known does not establish that such subject matter is in fact unquestionably well-known. As M.P.E.P. § 2144.03 makes clear, “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted). Although the Office Action alleges that *Lin* teaches a well known system and method, the Office Action does not provide substantial evidence on the record to show that the claimed subject matter was in fact unquestionably well-known. *Lin* merely mentions assigning a “confidence level to ... extracted features using a neural network” (col. 6, lines 56-58). Accordingly, Applicant expressly traverses any taking of Official Notice that the features of claims 7 and 27 were well known.

**Rejection of claims 51-54 under 35 U.S.C. § 103(a)**

The rejection of claims 51-54 under 35 U.S.C. § 103(a) should be withdrawn for at least the following reasons.

Independent claim 51 recites a combination including:

wherein the image capture device, the driver and the at least one tool are packaged and distributed together in order to facilitate an electronic beauty analysis.

*Yasuda* and *Skincheck*, alone and in combination, fail to teach or suggest at least the above subject matter. *Yasuda*’s system includes a “video camera 1 rotatably arranged on stanchion 2” (col. 2, line 45; FIG. 2). There is, however, no indication from *Yasuda* that an image capture device, a driver, and a tool for gathering information related to beauty are packaged and distributed together, as required by claim 51. *Skincheck* does not disclose, for example, an image capture device or driver and, thus, fails to cure *Yasuda*’s deficiencies. Accordingly, neither

*Yasuda* nor *Skincheck*, nor a combination thereof, teaches or suggests that “the image capture device, the driver and the at least one tool are packaged and distributed together in order to facilitate an electronic beauty analysis,” as recited in claim 51.

Moreover, the requisite motivation to combine the applied references is lacking. There is no motivation for combining *Skincheck* and *Yasuda* and the Office Action does not show the contrary. A skilled artisan would not have been motivated, without consulting Applicant’s disclosure, to combine *Skincheck* and *Yasuda* in a manner resulting in the invention defined by claim 51.

At page 6, the Office Action acknowledges that *Yasuda* fails to disclose a system “with a pH indicator.” The Office Action, however, alleges that pH indicators are “well known” and that “the inclusion of [a pH indicator] in a beauty kit is a matter of design choice” (pg. 6). The Office Action alleges (at page 8) that “it would have been an obvious matter of design choice to modify the system of *Yasuda* to provide a means of testing for pH as taught by *Skincheck*<sup>TM</sup> to obtain the invention as specified in the claims.” Without acquiescing to the characterizations of the claims set forth in the Office Action, Applicant traverses the allegations regarding “well known” features<sup>4</sup> and matters of “design choice.”

There is no “substantial evidence” in the record to support the alleged combination of *Yasuda* and *Skincheck*, and the requisite “clear and particular” motivation to support a *prima facie* case of obviousness is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan would have been motivated to combine *Yasuda* and *Skincheck*. Applicant

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<sup>4</sup> Applicant does not necessarily agree with the assertion that a pH indicator used for gathering information related to beauty was well known. And to the extent the conclusion in the Office Action are based on Official Notice, such Official Notice is expressly traversed. The Office Action has failed to establish that pH indicator was unquestionably well-known. Although the Office Action alleges that *Skincheck* teaches a pH indicator, the Office Action does not provide substantial evidence on the record to show that a pH indicator used for gathering information related to beauty was in fact unquestionably well-known. Accordingly, Applicant expressly traverses any taking of Official Notice.

notes that the requirements for establishing *prima facie* obviousness must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001). As mentioned above, M.P.E.P. § 2142 articulates:

Knowledge of applicant's disclosure must be put aside ....  
[I]mpermissible hindsight must be avoided and the legal  
conclusion must be reached on the basis of the facts gleaned from  
the prior art.

Applicant submits that the conclusions in the Office Action were not reached based on facts gleaned from the references. Rather, Applicant’s claims were used to reconstruct the prior art. The statement that “it would have been an obvious matter of design choice to modify the system of *Yasuda* to provide a means of testing for pH as taught by *Skincheck*™ to obtain the invention as specified in the claims,” for example, clearly evidences the improper reliance on Applicant’s disclosure. The requisite motivation to combine must “be found *in the prior art*.” M.P.E.P. § 2143 (8th ed. 2001) (emphasis added).

A skilled artisan would only arrive at the combination of elements recited in claim 51 by consulting Applicant’s disclosure. While *Skincheck* mentions pH indicators and *Yasuda* describes a hairdo selection system, neither of these references teaches or suggests combining their teachings as apparently proposed in the Office Action. Consequently, the conclusions in the Office Action constitute improper hindsight reasoning.

The Office Action further alleges, noting portions of Applicant’s specification, that Applicant has not disclosed that “using a pH indicator in combination with the image capture system and method of the invention provides an advantage, is used for a particular purpose, or solves a stated problem” (pg. 7). And in response to Applicant’s statement that “it is unclear why a skilled artisan would be inclined to include pH indicators with the [hairdo selection]



system of *Yasuda*,” the Office Action alleges that “a similar lack of a demonstration of criticality is demonstrated by the instant invention” (pg. 8).

The inquiry of whether a proper motivation exists focuses on “the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art,” not the so called “criticality” of subject matter. M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357). Whether or not Applicant’s specification includes an explanation of why an evaluation tool (which may include a pH indicator) might possibly be present is not germane to the issue of whether the requisite motivation exists for combining *Yasuda* and *Skincheck*. As noted in M.P.E.P. § 2141, the following factual inquiries are to be used when determining obviousness: “(A) Determining the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations.” Further, as M.P.E.P. § 2143.01 makes clear, the cited art must “[suggest] ... the desirability of the” combination. The fact that Applicant’s specification states that an evaluation tool (which may include a pH indicator) may or may not be present has absolutely no bearing on whether the applied art “suggests the desirability of the” combination and no bearing on whether certain claims are obvious. Again, Applicant notes that conclusions of obviousness “must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142.

For at least the foregoing reasons, a *prima facie* case of obviousness has not been established with respect to claim 51. The rejection of claim 51 under 35 U.S.C. § 103(a) should therefore be withdrawn. Claims 52-54 depend from claim 51. For at least the reasons presented above in connection with claim 51, the rejection of claims 52-54 should be withdrawn.

## **Conclusion**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner. The proposed amendments of claims 52-54 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Applicant amends claims 52-54 to cure minor informalities. This Amendment should therefore allow for immediate action by the Examiner. Further, entry of this Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicant therefore requests the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: March 24, 2004

By:   
Frank A. Italiano  
Reg. No. 53,056